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09/002,958

APPLICATION NO. 09/002,958	FILING DATE 01/06/98	FIRST NAMED INVENTOR SHEPARD	ATTORNEY DOCKET NO. 3453-1-41341
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EXAMINER NGUYEN, C
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ART UNIT 2764	PAPER NUMBER 3
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11/10/98

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**09/002,958**

Applicant(s)  
**Shepard, Franziska**

Examiner  
**Cuong H. Nguyen**

Group Art Unit  
**2764**



☒ Responsive to communication(s) filed on 1/06/98 (the amendment).

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-33 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-33 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Serial Number: 09/002,958  
Art Unit: 2764

#### **DETAILED ACTION**

1. This Office Action is the answer to the pre-amendment received on 1/06/98 (Mr. Daniel J. Meaney, Reg. No. 22,179).
2. Claims **1-33** are pending in this application.

#### ***Drawings***

3. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

#### ***Specification***

4. The disclosure is objected to because of the following informality:

On page 2 of the specification (right below the title)  
insert: --This application is a Continuation of United States  
Patent number 5,704,371 issued on January 06, 1998.--

Appropriate correction is required.

#### ***Double Patenting***

5. The non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper time-wise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ 2d 2010

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(Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

6. Claims **1-33** are rejected under the judicially created doctrine of non-obvious double patenting over the claims of **U. S. Pat. 5,704,371** issued on **1/06/98**; since these claims, if allowed, would improperly extend the "right to exclude" already granted in the previous patent.

The main subject matters claimed in the instant application are fully/inherently/obviously disclosed in US Pat. 5,704,371 and are covered by US Pat. 5,704,371; since that patent and the application are claiming common subject matters, as follows:

A. Per claim 1: In the current application, the inventor claims a documentation system, comprising:

- a preprinted form having recording sections;
- a recording means for recording on the preprinted format, and in the discrete section encoded indicium;
- an input member for recording information in the form of encoded indicia;
- a transcriber responsive to said encoded incidia for providing templates;

- a report prepared by the transcriber documenting the designated condition.

See claims 1, 17, and 18 of Shepard ('371).

B. Per claim 2: The inventor claims a medical documentation system comprising:

- apparatus for recording information;
- an input device for recording medical information communicated by a first person to a second person;
- a processor having medical report templates; said processor being operative to decode the encoded indicia into text segment, and producing reports.

See claims 2, and 7 of Shepard ('371).

C. Per claim 7: The inventor claims a medical documentation system comprising:

- a recording member with many sections;
- an input member for recording information in the form of encoded indicium;
- a computer with report templates comprising text variable segments; said computer being operative to decode the encoded indicia into text segments in discrete recording section, and storing them in a retrievable memory location; and
- an imaging member for preparing medical reports.

See claim 7 of Shepard ('371).

D. Per claim 17: The inventor claims a medical history documentation system comprising:

- a recording member with many discrete sections;
- an input member for recording information in the form of encoded indicium;
- a transcriber for providing report templates including four discrete report templates; and
- an imaging device for preparing medical reports.

See claim 17 of Shepard ('371).

E. Per claim 21: The inventor claims a method for documenting information for a designated condition comprising the steps of:

- conducting an examination of a designated condition;
- recording indicium by a second person on a device;
- processing said recorded indicia to produce a patient report; and
- comparing said patient report and said recorded indicia.

See claim 21 of Shepard ('371).

F. Per claim 22: The inventor claims a method for documenting verified information for a history file comprising the steps of:

- conducting a physical examination;
- recording information in the form of encoded indicium;
- processing said encoded indicium to produce a report; and

- comparing information on the report in said encoded indicia format.

See claim **22** of Shepard ('**371**).

The examiner submits that all these above claims contain similar meanings to independent claim 1, 2, 7, 17, 21, 22 ('**371**) which are within the breadth and scope of definition claimed in the prior patent (US Pat. 5,704,371). If allowed, the claims 1-33 of the application, not only would provide patent protection but would also extend patent coverage to the combination of claims 1-33; already disclosed and covered by the claims in previous patent. Thus, the controlling fact is that patent protection for the method/system, fully disclosed in and obviously covered by the claims of the prior patent, would be extended by the allowance of the claims in this application.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

7. A timely filed terminal disclaimer in compliance with 37 CFR 1.31(b) would overcome an actual or provisional rejection on a non-statutory double patenting ground provided the conflicting





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**Or:** (703) 308-5357 (for informal or draft  
communications, please label "PROPOSED" or  
"DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal  
Drive, Arlington. VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of  
this application should be directed to the Group receptionist  
whose telephone number is (703)305-3900.

Cuong H. Nguyen  
November 02, 1998



James R. Trammell  
Supervisory Patent Examiner  
Technology Center 2700